



UNITED STATES PATENT AND TRADEMARK OFFICE

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COPY MAILED

OCT 15 2007

OFFICE OF PETITIONS

In re Application of	:	
Douglas D. DeMasi	:	
Application No.: 10/773872	:	DECISION ON
Filing or 371(c) Date: 06/10/2004	:	PETITION
Title of Invention:	:	
SELF ADHESIVE INSULATION, WITH	:	
EXTENDED, PREFOLDED OR ELASTIC	:	
FASING TABS, SELF ADHESIVE NET,	:	
SELF ADHESIVE AIR VENT, SELF	:	
ADHESIVE PAPER HANGING	:	
SUPPORT STRIPS	:	

This is a decision in response to the correspondence filed October 23, 2006, in response to a Decision dismissing a petition to withdraw the holding of abandonment. The correspondence is properly treated as a renewed petition to withdraw the holding of abandonment under 37 CFR 1.181. The delay in treating this petition is regretted.

This Petition is hereby **dismissed**.

Any further petition must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under [insert the applicable code section]." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

The above-identified application became abandoned for failure to timely and properly reply to the Notice to File Corrected Application Papers, mailed August 16, 2004. The Notice set a two (3) month period for reply. Extensions of time were available under 37 CFR 1.136(a).

Applicant filed a Reply to the Notice on October 8, 2004; however, the reply was incomplete. Applicant was so notified in a Notice of Incomplete Reply, mailed October 25, 2004. The Notice of Incomplete Reply, mailed October 25, 2004 also stated that the period for reply remained as set forth in the Notice (which was two months from the mail date of the Notice mailed August 16, 2004).

No complete and proper reply to the August 16, 2004 Notice having been received, the application became abandoned on October 17, 2004. A Notice of Abandonment was mailed April 12, 2006.

May 23, 2006 Petition under 37 CFR 1.181

Applicant filed a petition to withdraw the holding of abandonment on May 23, 2006, wherein Applicant asserted that he mailed correspondence to this Office on April 19, 2006, and that he did not understand the Notice of Abandonment mailed April 12, 2006.

The October 23, 2006 Decision

A Decision on the petition to withdraw the holding of abandonment was mailed October 23, 2006. The Decision informed Applicant that:

1. The application became abandoned for failing to file a complete and proper reply to the August 16, 2004 Notice, which required additional claim fees of \$1,511.00.;
2. Extensions of time to respond to the Notice were available; however, extensions of time also require the appropriate extension of time fee, and that a list of current fees was available at www.uspto.gov;
3. The Notice clearly set forth the period for reply, and that it is Applicant's responsibility to ensure that a timely and proper reply is filed;
4. That Applicant was unsure or unclear as to the rules of practice in this office does not excuse Applicant of the responsibility to file a timely, complete and proper reply to the Notice, as the condition of the case requires, and
5. The application is abandoned and required revival

The Decision set forth the requirements for a grantable petition and also provided Applicant with contact information for the Office of Independent inventors and the Patent Assistance Center.

The present renewed petition

Applicant files the present renewed petition and asserts that there is confusion on the part of this office and of himself, and that he has copies of canceled checks to prove that required payments to this Office were made. Applicant states that he made the mistake of mailing two applications in one envelope, which resulted in a mix-up of the paperwork. Applicant encloses copies of what he has mailed to this Office.

Analysis

1. Abandonment of the Application

This application is abandoned. The Notice to File Corrected Application Papers that was mailed to Applicant on August 16, 2004 required Applicant to file a Substitute Specification and additional claim fees in the amount of \$1,511.00.

A review of the file reveals that Applicant received the Notice and mailed the Notice back to this Office on October 4, 2006, with comments stating that "enclosed is the extension fee. In 30 days, \$50.00 check #2280. Can you please mail me a copy of my application so I can better understand your correction that you want me to do."

Applicant is again informed that the Notice required Applicant to file a Substitute Specification and additional claim fees in the amount of \$1,511.00. The Notice required Applicant to file a Substitute Specification and additional claim fees in the amount of \$1,511.00 in two months.

Applicant is advised the an application goes abandoned according to statute and Office rules. The statute, 35 U.S.C. § 133, Time for prosecuting application, states

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

This section of the statute is further clarified in Office rule, 37 CFR § 1.135, Abandonment for failure to reply within time period, which states

- (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
- (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.
- (c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

This section explains that the reply must be both complete and proper as the condition of the application may require.

Here, Applicant filed a reply to the Notice that was neither complete or proper. Applicant is advised that, as provided in the Manual of Patent Examining Procedure,

[w]here an applicant contends that the application is not in fact abandoned (e.g., there is disagreement as to the sufficiency of the reply, or as to controlling dates), a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of abandonment is the appropriate course of action, and such petition does not require a fee. **Where there is no dispute as to whether an application is abandoned (e.g., the applicant's contentions merely involve the cause of abandonment), a petition under 37 CFR 1.137 (accompanied by the appropriate petition fee) is necessary to revive the abandoned application.**

MPEP 711.03(c).

Conclusion

Here, there is no dispute as to the status of the application. The application is abandoned. A petition to revive the application (and fee) is the appropriate course of action.

After a decision on any petition for reconsideration, to withdraw the holding of abandonment, under 37 CFR 1.181, no further reconsideration or review of the matter requesting withdrawal of the holding of abandonment will be undertaken by the Commissioner. Therefore, it is extremely important that petitioner supply **any** and **all** relevant information and documentation with his request for reconsideration. The Director's decision will be based solely on the administrative record in existence.

Alternate Venue

Applicant is urged to file a petition under 37 CFR 1.137(b) stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in was "unavoidable." An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required fee, currently \$750.00 for a small entity¹.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revive under 37 CFR 1.137(b).

Finally, it is apparent that Applicant is unaware of the options available in this matter. Applicant is advised that a list of registered practitioners is available at www.uspto.gov/main/patents. Applicant is further advised that there are two Offices: the Office of Independent Inventors, at

¹ Applicant is further advised that a grantable petition under 37 CFR 1.137(b) requires, in addition to the petition and petition fee, the required reply, to wit, an acceptable appeal brief; a continuing application; a Request for Continued Examination ("RCE"), or a reply that places the application in condition for allowance.

703-306-5568; and the Patent Assistance Center, at 1-800-786-9199, available to provide assistance in prosecuting patent applications.

Further correspondence with respect to this matter should be addressed as follows:


By mail: Director for Patents
PO Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

For inquiries on the options available to Applicant, Applicant is advised that a list of registered practitioners is available at www.uspto.gov/main/patents. Applicant is again advised that there are two Offices: the Office of Independent Inventors, at 703-306-5568; and the Patent Assistance Center, at 1-800-786-9199, available to provide assistance in prosecuting patent applications.

Telephone inquiries concerning this Decision should be directed to the undersigned at (571) 272-3232.


Derek L. Woods
Attorney
Office of Petitions